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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,549	04/30/2001	Anthony Mark Pasqualoni	341.6910USU	3388

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EXAMINER	
MARCHESCHI, MICHAEL A	
ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Appli ant(s)
	09/845,549	PASQUALONI ET AL.
	Examiner	Art Unit
	Michael A Marcheschi	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *30 and 31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicants are reminded to cancel the non-elected claims.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grumbine et al. (711) in view of Steckenrider et al. and Hampden-Smith et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al. (306) in view Hampden-Smith et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-8, 14, 15 and 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fang in view of Kaufman et al. (306) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-6, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. in view of Kaufman et al. (306) for the same reasons set forth in the previous office action which are incorporated herein by reference

Applicant's arguments filed 4/9/03 have been fully considered but they are not persuasive.

Applicants appear to argue that Grumbine et al. does not teach a "large particle count". The examiner acknowledges that this limitation is not **literally** defined, but as set forth in the

previous office action, this limitation is obvious. The examiner is aware of what is meant by "large particle count" (amount of particles having a specific size in a sample), but as previously defined, the claimed limitation "**less** than 150,000 particles having a size **greater** than about 0.5 microns" can be interpreted to mean that the composition contains **no** particles above 0.5 microns. As can be seen from the reference, all of the particles are below 0.4 microns (all particles throughout the composition will have a size less than 0.4 microns), thus reading on a composition that contains no particle above 0.5 microns (interpretation of the instantly claimed limitation). Although particles may agglomerate during shipment, this reference clearly states in column 10, lines 8-9 that the slurries are filtered **prior** to use, thus any large materials are removed prior to use. In addition, in example 3, it is shown that the slurry is filtered with a 0.2 micron filter, the other components are added and then that composition is used to polish a substrate, thus no shipment of the slurry is apparent in this example. It is therefore the examiners position that if any agglomeration occurs, it is at a minute level, if any. In summary, as can be seen from this example, it can be seen that all the abrasive particles are below 0.2 microns, thus reading on a slurry that contains no particles above 0.5 microns (interpretation of the instantly claimed limitation). Finally, applicants provide **no** comparative evidence over this reference which supports these arguments.

On page 9, second paragraph, applicants state that a prima facie case of obviousness has not been established. First, applicants provide no evidence to support this statement and second, applicants have not argued the combination, as applied in the previous office action, to the extent of the modification of Grumbine et al. with the secondary references. A broad statement that the action fails to establish a prima facie case of obviousness is not sufficient to rebut a rejection.

Applicants make a statement on page 10, third paragraph, as to the assumption made in the previous office action. The examiner is unclear as to what is being argued because the limitation "large particle count of **less** than 150,000 particles having a size **greater** than about 0.5 microns" can be interpreted to mean that the composition contains **no** particles above 0.5 microns. Since the reference clearly teaches this (all of the particles in the composition are below 0.5 microns), applicants remarks are moot.

Finally, applicants refer to the data defined in tables 1-2 of the instant specification and although this data might show results for the claimed particle count, as defined above, the reference teaches that the composition contain no particles above 0.5 microns, thus reading on the claimed particle count. In view of this, the examiner is unclear as to how these results show patentable evidence when the reference used clearly defines the claimed limitation.

Applicants appear to argue that Kaufman et al. does not teach a "large particle count". The examiner acknowledges that this limitation is not **literally** defined, but as set forth in the previous office action, this limitation is obvious. The examiner is aware of what is meant by "large particle count" (amount of particles having a specific size in a sample), but as previously defined, the claimed limitation "**less** than 150,000 particles having a size **greater** than about 0.5 microns" can be interpreted to mean that the composition contains **no** particles above 0.5 microns. As can be seen from the reference, all of the particles are below 0.4 microns (all particles throughout the composition will have a size less than 0.4 microns), thus reading on a composition that contains no particle above 0.5 microns (interpretation of the instantly claimed limitation). Although particles **may** (no evidence that they definitely will in the case of the

Kaufman et al reference) agglomerate during shipment, this reference clearly teaches in the examples that a slurry is made then it is used to polish a substrate, thus no shipment of the slurry is apparent in these examples. It is therefore the examiners position that if any agglomeration occurs, it is at a minute level, if any. In summary, as can be seen from this reference, it can be seen that all the abrasive particles are below 0.4 microns, thus reading on a slurry that contains no particles above 0.5 microns (interpretation of the instantly claimed limitation). Finally, applicants provide **no** comparative evidence over this reference which supports these arguments.

Applicants appear to argue that Fang does not teach a "large particle count". The examiner acknowledges that this limitation is not **literally** defined, but as set forth in the previous office action, this limitation is obvious. The examiner is aware of what is meant by "large particle count" (amount of particles having a specific size in a sample), but as previously defined, the claimed limitation "**less** than 150,000 particles having a size **greater** than about 0.5 microns" can be interpreted to mean that the composition contains **no** particles above 0.5 microns. As can be seen from the reference, all of the particles are below 0.5 microns (all particles throughout the composition will have a size less than 0.5 microns), thus reading on a composition that contains no particle above 0.5 microns (interpretation of the instantly claimed limitation). Although particles **may** (no evidence that they definitely will in the case of the Kaufman et al reference) agglomerate during shipment, this reference clearly teaches in the examples that a slurry is made then it is used to polish a substrate, thus no shipment of the slurry is apparent in these examples. It is therefore the examiners position that if any agglomeration occurs, it is at a minute level, if any. In summary, as can be seen from this reference, it can be

seen that all the abrasive particles are below 0.5 microns, thus reading on a slurry that contains no particles above 0.5 microns (interpretation of the instantly claimed limitation). Finally, applicants provide **no** comparative evidence over this reference which supports these arguments.

As a further statement which relates to all of the above rejections, the references do not contain any other particles besides the abrasive (i.e., all of the other components are liquids), thus the slurries will not contain any other solids which might be outside of the claimed particle count.

As a further comment, the instant claims do not set forth that any solids in the slurry (i.e. solids from components other than the abrasive) contribute to the particle count. The claims only refer to a particle count and this can interpreted as only referring to the abrasive particles in the dispersion.

Applicants appear to argue that Burk et al. does not teach a "large particle count". The examiner acknowledges that this limitation is not **literally** defined. The examiner is aware of what is meant by "large particle count" (amount of particles having a specific size in a sample), but as previously defined, the claimed limitation "**less** than 150,000 particles having a size **greater** than about 0.5 microns" can be interpreted to mean that the composition contains **no** particles above **about** 0.5 microns. The examiner acknowledges that the preexisting particles defined in the reference refer to the dissolved ferric salt oxidizer only. As can be seen from the reference, the preexisting particles have a size of 0.1 microns and the abrasive grains have a size of 0.2-0.7 microns. In view of this, the largest particle in the composition is 0.7 microns and this reads on a composition that contains **no** particles above 0.7 microns. Since applicants modify

the size of the particles with the term about and about permits some tolerance, *In re Ayers*, 154 F 2d 182, 69 USPQ 109, this reads on a size of 0.7 microns. In addition, even if the reference size of 0.7 microns is used, applicants have not shown that the large particle count of 150,000 in a 30 ul sample is not apparent in the reference. With respect to the method (filtering) any arguments based on these claims are moot since the rejection of said claims has been withdrawn.

The examiner withdraws the rejection of based on Lee et al., as the primary reference because, after further review this reference is less than the art relied upon in the above rejections.

In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. ***In re Opprecht*** **12 USPQ 2d 1235, 1236 (CAFC 1989);** ***In re Bode*** **USPQ 12;** ***In re Lamberti*** **192 USPQ 278;** ***In re Bozek*** **163 USPQ 545, 549 (CCPA 1969);** ***In re Van Mater*** **144 USPQ 421;** ***In re Jacoby*** **135 USPQ 317;** ***In re LeGrice*** **133 USPQ 365;** ***In re Preda*** **159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See** ***In re Van Marter*****, 144 USPQ 421.**

"A generic disclosure renders a claimed species prima facie obvious. ***Ex parte George*** **21 USPQ 2d 1057, 1060 (BPAI 1991);** ***In re Woodruff*** **16 USPQ 2d 1934;** ***Merk & Co. v. Biocraft Lab. Inc.*** **10 USPQ 2d 1843 (Fed. Cir. 1983);** ***In re Susi*** **169 USPQ 423 (CCPA 1971)".**

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see ***In re Malagari*****, 182 U.S.P.Q. 549;** ***In re Wertheim*** **191 USPQ 90 (CCPA 1976)".**

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Amendments can also be sent by fax to the numbers set forth below:

For after final amendments, the fax number is (703) 872-9311;

For non-final amendments, the fax number is 703 872-9310.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
Art unit 1755
6/03

MICHAEL MARCHESCHI
PRIMARY EXAMINER